

## **REMARKS**

### **Double Patenting Rejection**

Claim 19 stands rejected under the judicially created doctrine of obviousness-type double patenting over claim 2 in U.S. Patent No. 6,645,206. The Applicant has filed a Terminal Disclaimer herewith to obviate the double patenting rejection. Accordingly, withdrawal of the obviousness-type double patenting rejection is respectfully requested.

### **Allowable Claims**

As set forth on page 6 of the Office Action, claims 26-29, 31, 38, 39 and 44 have been objected to but have been indicated as allowable if rewritten in independent form. To that end, the Applicant has rewritten each of the claims 26, 31, 38, 39 and 44 in independent form. Additionally, claims 45, 46 and 49 have been amended to depend from rewritten independent claim 44. Accordingly, the Applicant submits that claims 26-29, 31, 38, 39 and 44-49 are now in condition for allowance.

### **Claim Rejections – 35 USC §102 and 103**

Claims 19, 30, 32 and 37 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,259,072 to Hirabayashi et al. (hereafter “the ‘072 reference”). Claims 32, 33, 40 and 45-49 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,591,235 to Kuslich (hereafter “the ‘235 reference”). Claims 40, 45, 49 and 50 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,645,596 to Kim et al. (hereafter “the ‘596 reference”). Claims 20-25 and 34-36 were rejected as being unpatentable

over the '072 reference in view of U.S. Patent No. 5,282,861 to Kaplan (hereafter "the '861 reference"). Claims 41-43 were rejected as being unpatentable over the '235 reference to Kuslich in view of the '861 reference to Kaplan.

It is well established that "an invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co. Ltd., 9 USPQ.2d 1913, 1920 (Fed. Cir. 1989).

**Independent Claim 19 and Dependent Claims 20-25 and 30**

Independent claim 19 was rejected as being anticipated by the '072 reference. Independent claim 19 has been amended to recite that the elongate body of the implant is substantially continuously tapered along its length. As shown in Figure 4 of the '072 patent, although the outer member 1 is illustrated as having a rounded leading end, the outer member 1 is clearly not "substantially continuously tapered" along its length, but instead defines a cylindrical outer profile along virtually its entire length. For at least these reasons, the Applicant submits that independent claim 19 is patentable over the references of record, whether considered alone or in combination with one another. Accordingly, the Applicant respectfully requests withdrawal of the rejection of amended independent claim 19. Claims 20-25 and 30 depend from amended independent claim 19 and are patentable for at least the reason supporting the patentability of independent base claim 19.

**Independent Claim 32 and Dependent Claims 33-37**

Independent claims 32 was rejected as being anticipated by the '072 reference and the '235 reference. Independent claim 32 has been amended to recite that the elongate body of the implant is substantially continuously tapered along its length. As shown in Figure 4 of the '072 patent, although the outer member 1 is illustrated as having a rounded leading end, the outer member 1 is clearly not "substantially continuously tapered" along its length, but instead defines a cylindrical outer profile along virtually its entire length. Similarly, the implant 14 illustrated and described in the '235 patent defines a cylindrical outer profile along its entire length. For at least these reasons, the Applicant submits that independent claim 32 is patentable over the references of record, whether considered alone or in combination with one another.

Accordingly, the Applicant respectfully requests withdrawal of the rejection of amended independent claim 32. Claims 33-37 depend from amended independent claim 32 and are patentable for at least the reason supporting the patentability of independent base claim 32.

**Independent Claim 40 and Dependent Claims 41-43**

Independent claims 40 was rejected as being anticipated by the '235 reference and the '596 reference. Independent claim 40 has been amended to recite that the elongate body has a pair of truncated side walls extending between the arcuate side walls, and a hollow interior and at least one opening in communication with the hollow interior. With regard to the '235 patent, the implant 14 does not disclose nor suggest the inclusion of truncated side walls extending between a pair of arcuate side walls. Instead, the implant 14 has a cylindrical outer profile along its entire length. With regard to the '596 reference, the implant 10 is solid and fails to teach or suggest

the inclusion of a hollow interior and at least one opening in communication with the hollow interior. For at least these reasons, the Applicant submits that independent claim 40 is patentable over the references of record, whether considered alone or in combination with one another. Accordingly, the Applicant respectfully requests withdrawal of the rejection of amended independent claim 40. Claims 41-43 depend from amended independent claim 40 and are patentable for at least the reason supporting the patentability of independent base claim 40.

**Independent Claim 50**

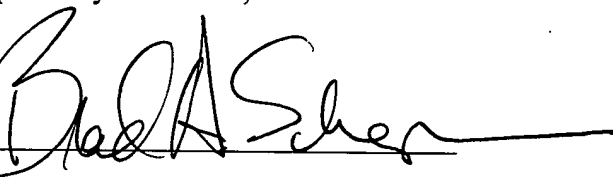
Dependent claim 50 was rejected as being anticipated by the '596 reference. Claim 50 has been rewritten in independent form and amended to recite, among other elements and features, an elongate body that is substantially continuously tapered along its length to define a substantially conical configuration. With regard to the '596 reference, the implant 10 is not substantially continuously tapered along its length to define a substantially conical configuration, but instead has an outer profile that defines an ovoidal or egg-shaped configuration. For at least these reasons, the Applicant submits that independent claim 50 is patentable over the references of record, whether considered alone or in combination with one another. Accordingly, the Applicant respectfully requests withdrawal of the rejection of rewritten independent claim 50.

## CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the Applicant's application is now in condition for allowance with pending claims 19-50.

Reconsideration of the subject application is respectfully requested. Timely action towards a Notice of Allowability is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the subject application.

Respectfully submitted,

By: 

Brad A. Schepers  
Reg. No. 45,431  
Woodard, Emhardt, Moriarty,  
McNett & Henry LLP  
Bank One Center/Tower  
111 Monument Circle, Suite 3700  
Indianapolis, Indiana 46204-5137  
(317) 634-3456 voice  
(317) 637-7561 facsimile